IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of:	)	Group Art Unit No.: 2625
Osama Elkady, et al.	)	Examiner: McLean, Neil R.
Serial No.: 10/733,102	)	Confirmation No.: 9183
Filed on: December 10, 2003	)	
For: GENERATING MERGED DOCUMENTS	)	

Mail Stop Appeals
Commissioner for Patents
P. O. Box 1450
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APPEAL BRIEF

Sir:

This Appeal Brief is submitted in support of the Notice of Appeal filed on August 11, 2010.

I. REAL PARTY IN INTEREST

Oracle International Corporation is the real party in interest.

II. RELATED APPEALS AND INTERFERENCES

Appellants are unaware of any related appeals or interferences.

III. STATUS OF CLAIMS

Claims 1–29 and 31 are pending in the application and were finally rejected in the Final Office Action mailed on May 11, 2010. Claims 30 and 32 were canceled during prosecution.

Claims 1–29 and 31 are the subject of this appeal.

IV. STATUS OF AMENDMENTS

No amendments were filed after the Final Office Action mailed on May 11, 2010.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The present application contains independent Claims 1 and 15. Claim 1 is a method claim and Claim 15 is a machine-readable storage medium counterpart of method Claim 1.

Among other purposes, the claims address the problem of printing merged documents, such as a text document overlaid upon a background document containing a logo and a watermark. *Specification* at 1, ll. 12–15. Conventional techniques require highly specialized and job-dependent software solutions, custom stationary, and/or specialized hardware. *Specification* at 1, ll. 16– 3 l. 14. By contrast, Appellants have invented hardware-independent techniques and products whereby a user may generate output from an arbitrary program and merge the generated output with a background template document. *Specification* at 5, ll. 19–24. Appellants' techniques specifically involve the use of a "merge utility" that executes on a computer system, as opposed to an output device. *Id.*; *Specification* at 7, ll. 21–23; 8, ll. 7–16. The merge utility may be, for example, "a computer system with one or more software components or processes operating in a computer system." *Specification* at 8, ll. 7–9.

Claim 1 provides a method for enabling the above desired implementation to be realized. Claim 1 is summarized below and annotated to cross-reference features of that claim to specific examples of those features disclosed in the specification. However, the annotations are not intended to limit the scope of the recited features to those specific examples to which the annotations refer:

Claim 1 involves "receiving, at a merge utility executing on a computer system, a request to merge a first merge document in a merge format with a second document in an original format." *E.g. Specification* at 11, ll. 23–24; 9, ll. 3–10. "[T]he second document was created in said original format by a first document authoring application." *E.g. Specification* at 15, ll. 12–14. Claim 1 further involves, "in response to the request, the merge utility causing the second document to be converted from the original format to the merge format to create a second merge document." *E.g. Specification* at 8, ll. 11–16. "[T]he second merge document is in the merge format." *E.g. id.* "[T]he step of converting is performed by either the merge utility or the first document authoring application." *E.g. id.*; *Specification* at 15, ll. 9–16. Claim 1 further involves "the merge utility merging the first merge document and the second merge document to generate a composite merge document." *E.g. Specification* at 8, ll. 21–23; 15, ll. 16–17; 19, ll. 20–23. Claim 1 further involves "after generating the composite merge document, the merge utility causing said composite merge document to be delivered to an output device." *E.g. Specification* at 20, ll. 7–9. "[T]he output device is a device that is different from the computer system." *E.g. Specification* at 9, ll. 13–14; 10, ll. 12–14, 20–21. "[T]he original format is a format that is not supported by the output device, and therefore needs to be converted to another format that is supported by the output device in order to be properly interpreted by the output device." *E.g. Specification* at 12, ll. 21–22. "[T]he merge format is a format that is supported by the output device, and therefore does not need to be converted to another format that is supported by the output device in order to be properly interpreted by the output device." *E.g. Specification* at id.; 8, ll. 5–6. "[T]he method is performed by one or more computing devices." *E.g. Specification* at 21, ll. 7–16.

Independent Claim 15 recites "[a] machine-readable storage medium storing one or more sequences of instructions, which when executed by one or more processors, causes" performance of same features recited above with respect to Claim 1. *E.g. Specification* at 22, ll. 13–23. Thus, the remainder of Claim 15 is supported by at least the same portions of the Specification as those cited above in connection with Claim 1. For completeness, Claim 15 is nonetheless summarized as follows. Execution of the instructions of Claim 15 causes, among other results, "receiving, at a merge utility executing on a computer system, a request to merge a first merge document in a merge format with a second document in an original format." *E.g. Specification* at 11, ll. 23–24; 9, ll. 3–10. "[T]he second document was created in said original format by a first document authoring application." *E.g. Specification* at 15, ll. 12–14. Execution of the instructions of

Claim 15 further causes, among other results, "in response to the request, the merge utility causing the second document to be converted from the original format to the merge format to create a second merge document." *E.g. Specification* at 8, ll. 11–16. "[T]he second merge document is in the merge format." *E.g. id.* "[T]he step of converting is performed by either the merge utility or the first document authoring application." *E.g. id.*; *Specification* at 15, ll. 9–16. Execution of the instructions of Claim 15 further causes, among other results, "the merge utility merging the first merge document and the second merge document to generate a composite merge document." *E.g. Specification* at 8, ll. 21–23; 15, ll. 16–17; 19, ll. 20–23. Execution of the instructions of Claim 15 further causes, among other results, "after generating the composite merge document, the merge utility causing said composite merge document to be delivered to an output device." *E.g. Specification* at 20, ll. 7–9. "[T]he output device is a device that is different from the computer system." *E.g. Specification* at 9, ll. 13–14; 10, ll. 12–14, 20–21. "[T]he original format is a format that is not supported by the output device, and therefore needs to be converted to another format that is supported by the output device in order to be properly interpreted by the output device." *E.g. Specification* at 12, ll. 21–22. "[T]he merge format is a format that is supported by the output device, and therefore does not need to be converted to another format that is supported by the output device in order to be properly interpreted by the output device." *E.g. Specification* at id.; 8, ll. 5–6. "[T]he method is performed by one or more computing devices." *E.g. Specification* at 21, ll. 7–16.

VI. GROUNDS OF REJECTION TO BE REVIEWED UPON APPEAL

1. Whether Claims 1–29 and 31 are unpatentable over U.S. Patent No. 7,099,027 (hereinafter "*Barry*") in view of U.S. Patent No. 7,202,972 (hereinafter "*Schwier*") under 35 U.S.C. §103(a).

VII. ARGUMENTS

A. The Examiner Has Erred in Rejecting Claims 1–29 and 31 under 35 U.S.C. §103(a)

Claims 1–29 and 31 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable U.S. Patent No. 7,099,027 (hereinafter "*Barry*") in view of U.S. Patent No. 7,202,972 (hereinafter "*Schwier*"). Applicants submit that the rejection is improper and request that the rejection be reversed.

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co.* v. *Teleflex Inc.*, 127 S.Ct. 1727, 1734, 82 USPQ2d 1385, 1391 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art. . . . *Graham* v. *John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966). *See also* KSR, 127 S.Ct. at 1734, 82 USPQ2d at 1391. "If a court, or patent examiner, conducts this analysis and concludes the claimed subject matter was obvious, the claim is invalid under §103."

In the present matter, the Examiner has made clearly erroneous factual findings regarding the scope and content of the prior art, and in particular, what certain cited prior art references teach. For at least this reason, the Examiner's analysis and the rejection based thereon are invalid.

INDEPENDENT CLAIM 1

Among other aspects, Claim 1 recites elements that are performed by "a merge utility, executing on a computer system" to merge at least two input documents into a "composite merge document" that can be sent to an "output device . . . that is different from the computer system." Specifically, the merge utility receives "a request to merge a first merge document in a merge format with a second document in an original format." Since the original format of the second document "is not supported by the output device," the merge utility responds to the request by "causing the second document to be converted . . . to the merge format," which format is capable of being "properly interpreted by the output device." The merge utility thereby generates "a second merge document." The merge utility then merges the first and second merge documents "to generate [the] composite merge document." The composite merge document is then delivered to the output device.

For example, the merge utility may receive a request to merge a document (an example second document) saved in Word (an example original format) with a background template (an example first merge document) stored as a PostScript file (an example merge format). In response to the request, the merge utility may cause the Word document to be converted to PostScript format, thereby yielding an example second merge document. The merge utility may then merge the converted Word document and the background template into a single PostScript file (the composite merge document). The merge utility may then cause the merged document to be delivered to a printer (an example output device).

By contrast, *Barry*, to the extent relied upon by the Office in rejecting Claim 1, describes a networked-based distributed print job system in which a print job is routed from an application at one computer system, over a network, and to a distribution node. *Barry* at abstract. The print job is sent to the distribution node in the form of a PDL input. *Barry* at FIG. 8. While at the distribution node, the print job may be merged with additional PDL information, such as a background graphic. *Barry* at FIG. 8; col. 13, lines 10–40.

By further contrast, *Schwier*, to the extent relied upon by the Office in rejecting Claim 1, describes the conversion of a document from an application format such as Word to a RAW data stream, which may then be sent to a printer device. *Schwier* at FIG. 8. *Schwier* further describes techniques for filtering a merged EMF document into two separate streams, which are then converted to PCL and sent separately to a printer. *Schwier* at FIG. 2. The PCL streams are then combined by the printer. *Id.*

The cited references fail to render obvious such a method for at least the following reasons:

(1) *Neither reference teaches that a merge utility responds to a request to merge a document in an original format with a document in a merge format.*

Claim 1 recites "receiving, at a merge utility executing on a computer system, a request to merge a first merge document in a merge format with a second document in an original format." Furthermore, one or more of the steps of Claim 1 are performed "in response to the request." Neither *Barry*'s nor *Schwier*'s alleged merge utilities receive or respond to such a request.

The Office alleges that *Barry*'s summing junction box 804 is a merge utility within the meaning of Claim 1. *Final Office Action* of May 11, 2010 (hereinafter *Final Office Action*) at 5. Though it is not entirely clear that this alleged merge utility executes at a computer system that is different than the output device, as recited in Claim 1, it is nonetheless clear that this alleged merge utility does not receive a "request" within the meaning of Claim 1. Rather, the alleged merge utility responds to a request to merge two documents that are already in a merge format, *e.g. Barry* at FIG. 8 (showing both inputs to be PDL). A request to merge two documents that are already in a merge format cannot possibly be "a request to merge a first merge document in a merge format with a second document in an original format," as recited in Claim 1.

Moreover, while it is not clear which aspect of *Schwier*, if any, the Office presently alleges to correspond to a "merge utility" within the meaning of Claim 1, it is nonetheless clear that *Schwier* also does not describe receiving or responding to the request recited in Claim 1. In *Schwier*, the only "requests to merge documents" appear to be a request to application 10 to merge variable and static data and a request to printer 7 to merge variable and static data at printer 7. *E.g. Schwier* at FIG. 2; col. 5, lines 30–38; col. 7, lines 4–9. However, both inputs to application 10 are in an original format. *E.g. Schwier* at col. 5, lines 30–38 (describing static data 12 as a "Winword" document and variable data 11 as data from a separate Word, Excel, or data bank file). Meanwhile, aside from the fact that printer 7 is not a merge utility at a computer system that is different than the output device, as recited in Claim 1, both inputs to printer 7 are already in a merge format. *E.g. Schwier* at FIG. 2 (showing that both the variable stream 15 and static stream 16 are PCL-formatted). Thus, neither scenario features "a request to merge a first merge document in a merge format with a second document in an original format," as recited in Claim 1.

The Office nonetheless appears to allege that the request recited in Claim 1 is an inherent aspect of *Schwier*'s system. *Final Office Action* at 3 ("in order to merge the system must receive a merge command"). However, even if *Schwier* did explicitly describe a "merge request" of some form, which *Schwier* does not, the Office still fails to produce any evidence that this "request" is the same kind of request as recited in Claim 1—that is, a "request to merge a first merge document in a merge format with a second document in an original format."

The absence of such a request from the combination of *Barry* and *Schwier* is far from trivial. One certainly may, as the Office appears to be alleging, achieve results similar to those achieved by Claim 1 by converting an original document to a merge document, per *Scwhier*, and then merging the converted document with another merge document, per *Barry*. However, Applicants are not claiming an end result, but a method for achieving a result. Whereas the proposed combination of references would require separate requests to separate components in order to accomplish the conversion and merger, the method of Claim 1 facilitates the use of a single merge utility to achieve both the conversion and the merger. The cited references simply fail to teach or suggest any method involving a single merge utility that is capable of merging a document in an original format with a document in a merge format in response to a single request.

Thus, neither *Barry* nor *Schwier* render obvious "receiving [and responding to], at a merge utility executing on a computer system, a request to merge a first merge document in a merge format with a second document in an original format.

(2) <u>Neither reference features a merge utility that causes a document to be converted from an original format to a merge format</u>

Claim 1 further recites that "in response to the request, the merge utility caus[es] the second document to be converted from the original format to the merge format to create a second merge document." Neither *Barry*'s nor *Scwhier*'s alleged merge utilities cause an input document to be converted from an original format to a merge format.

The Office already acknowledges that *Barry* is silent as to a conversion of a document from an original format to a merge format, within the meaning of Claim 1. *Final Office Action* at 2. The Office instead appears to allege that *Schwier* teaches such a merge utility because, in

Schwier, a Word document is eventually converted to a PCL document. *Final Office Action* at 3. While Applicants agree that it is clearly well known to convert a Word document to a PCL document, the allegation is nonetheless clearly factually incorrect, in that the component responsible for causing the conversion in *Schwier* is not a "merge utility" within the meaning of Claim 1.

In *Schwier*, conversion from an original format to a merge format is caused by a PCL converter 18. *Schwier* at FIG. 2; col. 7, 7–9; *see also* FIG. 9 (illustrating the converter as "EMF->PCL Convertor 58"). This converter is not a merge utility. In fact, PCL converter 18 functions in the opposite manner of a merge utility, in that PCL converter 18 filters or splits a single data stream into multiple data streams. *Schwier* at FIG. 2; col. 7, 7–9. Meanwhile, the only components of *Schwier* that do perform a merger, application 10 and printer 7, do not cause or perform any conversion operations. Thus, *Schwier* cannot possibly teach or suggest that "the merge utility caus[es] the second document to be converted from the original format to the merge format to create a second merge document" as recited in Claim 1.

For at least the foregoing reasons, the combination of *Barry* and *Schwier* fails to provide the complete subject matter recited in independent Claim 1. Therefore, the combination of *Barry* and *Schwier* would not have rendered Claim 1 obvious under 35 U.S.C. § 103. The rejection under 35 U.S.C. § 103 as to Claim 1 must therefore be reversed.

INDEPENDENT CLAIM 15

Independent Claim 15 also recites features argued above with relation to Claim 1, although Claim 15 is expressed in another format. Because Claim 15 has at least one of the features described above for Claim 1, Claim 15 is therefore allowable over the combination of *Barry* and *Schwier* for at least one of the same reasons as given above for Claim 1. Thus, Applicants likewise request reversal of the 35 U.S.C. § 103 rejection with respect to Claim 15.

DEPENDENT CLAIMS 9 AND 23

Dependent Claim 9 recites that "causing the second document to be converted from the original format to the merge format to create the second merge document includes: . . . passing [a] set of conversion instructions from the merge utility to the first document authoring application . . . [that] cause the first document authoring application to generate the second merge document based on said set of conversion instructions." Thus, Claim 9 teaches that, in response to the merge request recited in Claim 1, a merge utility passes conversion instructions to the document authoring application in which the second document was created. These instructions cause the document authoring application to convert the second document from the original format to the merge format.

(1) *Passing instructions to* Schwier*'s PCL Convertor 18 does not teach or suggest passing instructions to a document authoring application that produced the document in the original format*

The Office alleges that the above-quoted elements of Claim 9 are taught in *Schwier* at FIG. 2 and column 4, lines 15–20. *Final Office Action* at 10. The allegation is clearly factually erroneous, for at least the reason that, while this passage of *Schwier* may state that an application sends an instruction to a PCL convertor 18 to convert a document, PCL convertor 18 is not a "document authoring application" in any sense, much less within the meaning recited in Claim 1. That is, Claim 1 recites that "the second document was created in [the] original format by [the] first document authoring application." *Schwier* does not teach or suggest that PCL convertor 18 was used to create any alleged "original document." Nor is PCL convertor 18 capable of generating a document in an original format. Rather, the entire purpose of PCL convertor 18 is to convert a document to PCL, which is a merge format within the meaning of Claim 1, in that it is supported by *Schwier*'s printing device. *E.g. Schwier* at FIG. 9.

(2) *Passing conversion instructions to Schwier's PCL Convertor 18 after merger does not teach or suggest passing conversion instructions to a document authoring application before merger*

Moreover, *Schwier*'s application does not pass instructions to the PCL convertor until after the application has already performed a merge operation. *E.g. Schwier* at FIG. 2. Claim 9, on the other hand, recites that this step occurs as part of converting the second document prior to merging the first merge document with the second merge document. In other words, the instructions in *Schwier* are to convert an already combined output document, not a single input document as recited in Claim 9.

Barry does not, and is not alleged to teach the above-quoted elements. For at least the above reasons, then, the combination of *Barry* and *Schwier* clearly does not teach or suggest the above-quoted element of Claim 9. Therefore, the combination of *Barry* and *Schwier* would not have rendered Claim 9 obvious under 35 U.S.C. § 103. Claim 23 recites the same above-quoted elements and thus the combination of *Barry* and *Schwier* also would not have rendered Claim 23 obvious under 35 U.S.C. § 103. The rejection under 35 U.S.C. § 103 as to Claims 9 and 23 must therefore be reversed

DEPENDENT CLAIMS 10 AND 24

Claim 10 recites that the request of Claim 1, as discussed above, "contains information about the first document authoring application." Claim 10 continues, "the merge utility generat[es], based on the information about the first document authoring application, a set of conversion instructions to convert the second document into said second merge document." Therefore, the method of Claim 10 recites that a merge utility generates conversion instructions based at least upon information about a document authoring application that was included in the original merge request. The conversion instructions may then be used to cause the conversion of the second document by the document authoring application, similar to Claim 9.

(1) Schwier *does not describe a merge request that "contains information about the first document authoring application."*

The Office alleges that *Schwier*'s merge request "contains information about the first document authoring application" because *Schwier* states in col. 4, lines 25–26, that "the referencing is thereby particularly controlled via data that are input via a user interface." *Final Office Action* at 10. Clearly, the allegation is in error. This passage of *Schwier* has nothing to do with a merge request, much less "information about the first document authoring application." Clearly, the passage cannot teach or suggest that a merge request "contains information about the first document authoring application."

(2) The mere fact that PCL convertor 18 is enabled by program code or a device does not show that a set of conversion instructions is generated "based on the information about the document authoring application" included in the merge request

The Office further alleges that *Schwier* teaches that a set of conversion instructions is generated "based on the information about the document authoring application" included in the merge request because of "the program code or device which enables the PCL converter 18 in Figure 2." *Final Office Action* at 10. Again, the allegation is clearly in error. *Schwier* does not teach or suggest that the "program code or device which enables the PCL converter 18" is generated "based on the information about the document authoring application" included in the merge request. Thus *Schwier* does not teach or suggest the above quoted elements.

Barry does not, and is not alleged to teach the above-quoted elements. For at least the above reasons, then, the combination of *Barry* and *Schwier* clearly does not teach or suggest the above-quoted element of Claim 10. Therefore, the combination of *Barry* and *Schwier* would not have rendered Claim 10 obvious under 35 U.S.C. § 103. Claim 24 recites the same above-quoted elements and thus the combination of *Barry* and *Schwier* also would not have rendered Claim 24 obvious under 35 U.S.C. § 103. The rejection under 35 U.S.C. § 103 as to Claims 10 and 24 must therefore be reversed.

DEPENDENT CLAIMS 13 AND 27

Dependent Claim 13 recites that "the steps of causing the second document to be converted and merging the first merge document and the second merge document are both performed in response to the merge utility receiving the request to merge documents." The Office alleges that this claim is obvious because of "the program code which is embodied on a computer readable media and operable to requests [sic] the merge utility described in Column 6, lines 8–18 to merge documents." *Final Office Action* at 12.

It is not clear to which reference the *Final Office Action* refers. Nor is it clear how the allegation in any way relates to the subject matter recited in Claim 13. In any event, neither reference describes that "causing the second document to be converted and merging the first merge document and the second merge document are both performed in response to the merge utility receiving the request to merge documents." For at least the above reasons, then, the combination of *Barry* and *Schwier* clearly does not teach or suggest the above-quoted element of Claim 13. Therefore, the combination of *Barry* and *Schwier* would not have rendered Claim 13 obvious under 35 U.S.C. § 103. Claim 27 recites the same above-quoted elements and thus the combination of *Barry* and *Schwier* also would not have rendered Claim 27 obvious under 35 U.S.C. § 103. The rejection under 35 U.S.C. § 103 as to Claims 13 and 27 must therefore be reversed.

DEPENDENT CLAIMS 3, 4, 17, AND 18

Claim 3 clarifies that "the merge format is Standard Printing and Imaging Format (SPIF)." Claim 4 clarifies that "the merge format is PDL Postscript." The Office alleges that both claims are obvious in view of *Schwier* at col. 3, lines 63–64, which describes the conversion of an EMF data stream into PCL or postscript. Applicants do not dispute that PCL and postscript are well-known examples of a merge format, within the meaning of Claim 1. However, the Office appears to ignore the significance of Claims 3 and 4.

In clarifying that the merge format is SPIF or PDL PostScript, Claims 3 and 4 also clarify that the first document is in the respective recited format, while the second document is in a format other than the respective recited format. The Office cannot and does not even attempt to show how either reference teaches that one input into a merge utility is in SPIF or PDL PostScript, while another input is not in SPIF or PDL PostScript. Thus, the cited references do not render obvious Claim 3's recitation that "the merge format is Standard Printing and Imaging Format (SPIF)" or Claim 4's recitation that "the merge format is PDL Postscript."

For at least the foregoing reasons, the combination of *Barry* and *Schwier* fails to provide the complete subject matter recited in dependent Claims 3 and 4. Therefore, the combination of *Barry* and *Schwier* would not have rendered Claims 3 and 4 obvious under 35 U.S.C. § 103. Claims 17 and 18 recite the same above-quoted elements and thus the combination of *Barry* and *Schwier* also would not have rendered Claims 17 and 18 obvious under 35 U.S.C. § 103. The rejection under 35 U.S.C. § 103 as to Claims 3, 4, 17, and 18 must therefore be reversed.

DEPENDENT CLAIMS 6 AND 20

Claim 6 recites that the first document "is originally created by a second document authoring application; and . . . the second document authoring application is different from said first document authoring application." Thus Claim 6 recites that the input documents are created with different authoring applications. The Office alleges that this step is taught in *Scwhier* because the variable data 11 and static data 12 may be generated by different applications. *Final Office Action* at 9. The allegation is erroneous. Neither variable data 11 nor static data 12 can be the "first document" of Claim 6, in that neither is in a merge format. Therefore, neither variable data 11 nor static data 12 can be relied upon to teach or suggest that the first document is "created by a second document authoring application" that "is different from said first document authoring application."

For at least the foregoing reasons, the combination of *Barry* and *Schwier* fails to provide the complete subject matter recited in dependent Claim 6. Therefore, the combination of *Barry* and *Schwier* would not have rendered Claim 6 obvious under 35 U.S.C. § 103. Claim 20 recites the same above-quoted elements and thus the combination of *Barry* and *Schwier* also would not have rendered Claim 20 obvious under 35 U.S.C. § 103. The rejection under 35 U.S.C. § 103 as to Claims 6 and 20 must therefore be reversed.

DEPENDENT CLAIMS 2, 5, 7–8, 11–12, 14, 16, 19, 21–22, 25–26, 28, 29, AND 31

Each of Claims 2, 5, 7–8, 11–12, 14, 16, 19, 21–22, 25–26, 28, 29, and 31 depends from Claim 1 or 15, and includes the above-quoted features of its parent claim by dependency. Thus, the combination of *Barry* and *Schwier* also fails to teach or suggest at least one feature found in Claims 2, 5, 7–8, 11–12, 14, 16, 19, 21–22, 25–26, 28, 29, and 31. Therefore, the combination of *Barry* and *Schwier* does not render obvious Claims 2, 5, 7–8, 11–12, 14, 16, 19, 21–22, 25–26, 28, 29, and 31. Thus, Applicants likewise request reversal of the 35 U.S.C. § 103 rejection with respect to Claims 2, 5, 7–8, 11–12, 14, 16, 19, 21–22, 25–26, 28, 29, and 31.

VIII. CONCLUSION AND PRAYER FOR RELIEF

Based on the foregoing, it is respectfully submitted that the rejections of Claims 1–29 and 31 are improper and lack the requisite factual and legal bases. Therefore, Appellants respectfully request that the Honorable Board reverse the rejections of Claims 1–29 and 31, and hold the claims to be allowable.

Respectfully submitted,
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CLAIMS APPENDIX

1. (Previously Presented) A method comprising:

receiving, at a merge utility executing on a computer system, a request to merge a first merge document in a merge format with a second document in an original format;

wherein the second document was created in said original format by a first document authoring application;

in response to the request, the merge utility causing the second document to be converted from the original format to the merge format to create a second merge document;

wherein the second merge document is in the merge format;

wherein the step of converting is performed by either the merge utility or the first document authoring application;

the merge utility merging the first merge document and the second merge document to generate a composite merge document; and

after generating the composite merge document, the merge utility causing said composite merge document to be delivered to an output device;

wherein the output device is a device that is different from the computer system;

wherein the original format is a format that is not supported by the output device, and therefore needs to be converted to another format that is supported by the output device in order to be properly interpreted by the output device; and

wherein the merge format is a format that is supported by the output device, and therefore does not need to be converted to another format that is supported by the output device in order to be properly interpreted by the output device;

wherein the method is performed by one or more computing devices.

2. (original) The method of Claim 1 further comprising:

generating the first merge document in said merge format by converting a first original document from an original format to the merge format.

3. (original) The method of Claim1, wherein the merge format is Standard Printing and Imaging Format (SPIF).

4. (original) The method of Claim 3, wherein the merge format is PDL Postscript.

5. (original) The method of Claim 1, wherein the first document is a background template document and the second document is an overlay document.

6. (Previously Presented) The method of Claim 5,

wherein the background template document is originally created by a second document authoring application; and

wherein the second document authoring application is different from said first document authoring application.

7. (original) The method of Claim 5, wherein the background template document is created in a second original format and converted from the second original format to the merge format.

8. (Previously Presented) The method of claim 1, wherein causing the second document to be converted from the original format to the merge format comprises the merge utility converting the second document to the merge format.

9. (Previously Presented) The method of Claim 1, wherein causing the second document to be converted from the original format to the merge format to create the second merge document includes:

the merge utility generating, based on the original format, a set of conversion instructions to convert the second document into said second merge document;

passing the set of conversion instructions from the merge utility to the first document authoring application;

wherein the conversion instructions, when interpreted by the first document authoring application, cause the first document authoring application to generate the second merge document based on said set of conversion instructions.

10. (Previously Presented) The method of Claim 1, wherein the request contains information about the first document authoring application, wherein causing the second document to be converted from the original format to the merge format to create the second merge document includes:

the merge utility generating, based on the information about the first document authoring application, a set of conversion instructions to convert the second document into said second merge document;

passing the set of conversion instructions from the merge utility to the first document authoring application; and

wherein the conversion instructions, when interpreted by the first document authoring application, cause the first document authoring application to generate the second merge document based on said set of conversion instructions.

11. (original) The method of Claim 1, wherein the composite merge document is in the merge format.

12. (original) The method of Claim 1, wherein the composite merge document is a template for creating other documents.

13. (Previously Presented) The method of Claim 1,

wherein the steps of causing the second document to be converted and merging the first merge document and the second merge document are both performed in response to the merge utility receiving the request to merge documents.

14. (Previously Presented) The method of Claim 1 further comprising:

generating the first merge document in said merge format by converting a first original document from an original format to the merge format;

wherein the merge format is Standard Printing and Imaging Format (SPIF);

wherein the first document is a background template document and the second document is an overlay document;

wherein the background template document is originally created by a second document authoring application; and

wherein the second document authoring application is different from said first document authoring application;

wherein the background template document is created in a second original format and converted from the second original format to the merge format.

15. (Previously Presented) A machine-readable storage medium storing one or more sequences of instructions, which when executed by one or more processors, causes:

receiving, at a merge utility executing on a computer system, a request to merge a first merge document in a merge format with a second document in an original format;

wherein the second document was created in said original format by a first document authoring application;

in response to the request, the merge utility causing the second document to be converted from the original format to the merge format to create a second merge document;

wherein the second merge document is in the merge format;

wherein the step of converting is performed by either the merge utility or the first document authoring application;

the merge utility merging the first merge document and the second merge document to generate a composite merge document; and

after generating the composite merge document, the merge utility causing said composite merge document to be delivered to an output device;

wherein the output device is a device that is different from the computer system;

wherein the original format is a format that is not supported by the output device, and therefore needs to be converted to another format that is supported by the output device in order to be properly interpreted by the output device; and

wherein the merge format is a format that is supported by the output device, and therefore does not need to be converted to another format that is supported by the output device in order to be properly interpreted by the output device.

16. (previously presented) The machine-readable storage medium of Claim 15, wherein the one or more sequences of instructions, when executed by one or more processors, further causes:

generating the first merge document in said merge format by converting a first original document from an original format to the merge format.

17. (previously presented) The machine-readable storage medium of Claim 15 wherein the merge format is Standard Printing and Imaging Format (SPIF).

18. (previously presented) The machine-readable storage medium of Claim 17 wherein the merge format is PDL Postscript.

19. (previously presented) The machine-readable storage medium of Claim 15 wherein the first document is a background template document and the second document is an overlay document.

20. (previously presented) The machine-readable storage medium of Claim 19,

wherein the background template document is originally created by a second document authoring application; and

wherein the second document authoring application is different from said first document authoring application.

21. (previously presented) The machine-readable storage medium of Claim 19 wherein the background template document is created in a second original format and converted from the second original format to the merge format.

22. (Previously Presented) The machine-readable storage medium of Claim 15 wherein causing the second document to be converted from the original format to the merge format comprises the merge utility converting the second document to the merge format.

23. (Previously Presented) The machine-readable storage medium of Claim 15 wherein causing the second document to be converted from the original format to the merge format to create the second merge document includes:

the merge utility generating, based on the original format, a set of conversion instructions to convert the second document into said second merge document;

passing the set of conversion instructions from the merge utility to the first document authoring application;

wherein the conversion instructions, when interpreted by the first document authoring application, cause the first document authoring application to generate the second merge document based on said set of conversion instructions.

24. (Previously Presented) The machine-readable storage medium of Claim 15 wherein the request contains information about the first document authoring application, wherein causing the second document to be converted from the original format to the merge format to create the second merge document includes:

the merge utility generating, based on the information about the first document authoring application, a set of conversion instructions to convert the second document into said second merge document;

passing the set of conversion instructions from the merge utility to the first document authoring application; and

wherein the conversion instructions, when interpreted by the first document authoring application, cause the first document authoring application to generate the second merge document based on said set of conversion instructions.

25. (previously presented) The machine-readable storage medium of Claim 15 wherein the composite merge document is in the merge format.

26. (previously presented) The machine-readable storage medium of Claim 15 wherein the composite merge document is a template for creating other documents.

27. (Previously Presented) The machine-readable storage medium of Claim 15

wherein the steps of causing the second document to be converted and merging the first merge document and the second merge document are both performed in response to the merge utility receiving the request to merge documents.

28. (Previously Presented) The machine-readable storage medium of Claim 15 wherein the one or more sequences of instructions, when executed by one or more processors, further causes :

generating the first merge document in said merge format by converting a first original document from an original format to the merge format;

wherein the merge format is Standard Printing and Imaging Format (SPIF);

wherein the first document is a background template document and the second document is an overlay document;

wherein the background template document is originally created by a second document authoring application; and

wherein the second document authoring application is different from said first document authoring application;

wherein the background template document is created in a second original format and converted from the second original format to the merge format.

29. (previously presented) The method of Claim 1, wherein the first merge document is a version of a first document that has been converted from an original format to the merge format.

30. (Canceled)

31. (previously presented) The machine-readable storage medium of Claim 15 wherein the first merge document is a version of a first document that has been converted from an original format to the merge format.

32. (Canceled)

EVIDENCE APPENDIX

None.

RELATED PROCEEDINGS APPENDIX

None.